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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,379	09/04/2001	Wolfgang Moderegger	007413-049	1270

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/944,379	Applicant(s) MODEREGGER ET AL.	
	Examiner Steven B. McAllister	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 44-48, 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 and 49-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2005 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-10, 13-15, 18, 19, 26, 33, 38-41, 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Fields (2002/00069154).

Fields shows providing a database having at least one performance description and one price for each performance; generating a list of performances; forwarding the list to a plurality of bidders; receiving a bid from at one of the bidders, each having a price determined by the bidder; evaluating the bids and selecting one; and automatically

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updating the database such that the price associated with the performances is updated to reflect the selected bid (pg. 7, par. 90).

As to claim 3, it is noted that the performance description is updated, for example specifying a number of moving parts in the invention.

As to claim 10, it is noted that the database comprises a price term independent of region (national price) and a regionally dependent price correction term comprising a regionally dependent price. The regionally dependent price correction term provides correction for the pricing in a particular area. (It is noted that claim 10 does not recite that the regionally dependent price correction term is used to modify the national price).

As to claim 43, it is noted that since the past bids are used to recalculate and update the cost figures, those price comprise a plurality of past bid prices.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 10-12, 16, 20,21, 34-36, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields.

As to claims 4-6, Fields shows all elements except modifying or adding a performance and saving it in the database as a new performance. However, the

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examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method Fields by modifying or adding and saving performance descriptions as new performances in order to provide a more comprehensive listing of performance descriptions for future users to choose from.

As to claims 10-12, Fields shows all elements except determining the price of a performance from the region-independent price and a regionally dependent price correction term and updating only the independent price. However, the examiner takes official notice that to determine and update a regional price in this way is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method Fields by applying a regional correction term to an independent price in order to facilitate easy database maintenance.

Additionally as to claim 10-11, Fields shows all elements except providing regionally dependent price correction term and determining the price of a performance from the region-independent price and a regionally dependent price correction term. However, it would have been an obvious matter of design choice to determine regional prices in this way since it does not appear that this particular method of determining regional prices solves a particular problem or is for a specific purpose, and it appears that the method would function equally well with either method.

As to claim 16, Fields shows all elements except securing the list upon its completion. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art

to secure the created list in order to ensure that the list is not changed during the bidding process, creating inaccurate bids.

As to claim 20, Fields shows all elements except not disclosing the bid to the buyer. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to maintain bids secret until the deadline in order to prevent bid rigging.

Additionally, it is noted that claim 20 is interpreted as an obvious variant over claim 19. Were it determined that claim 20 is patentably distinct from claim 19, a species requirement would be necessary.

As to claim 21, Fields shows all elements except showing time of receipt of a bid. However, the examiner takes official notice that to do so is notoriously old and well known. It would have been obvious to one of ordinary skill in the art to include the time of receipt in order to maintain good housekeeping records and to provide proof that the bid arrived before the deadline.

As to claim 34, Fields shows all elements except automatic notification of losing bidders. However, the examiner takes official notice that to do so is notoriously old and well known in the art (e.g., ebay). It would have been obvious to one of ordinary skill in the art to modify the method Fields by providing such notification in order to ensure timely notification of losing bidders.

As to claims 35-36, Fields shows all elements except automatically sending a list of performances to the winning bidder. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one

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of ordinary skill in the art to generate and provide such a list in order to facilitate the creation of a contract between the bidder and buyer in a timely manner.

As to claim 42, Fields shows all elements except the price description comprising a performance description comprising time to perform a performance, and a rate per hour. However, the examiner takes official notice that to do so is notoriously old and well known in the art (e.g., determining the cost of an auto repair by retrieving the “book rate” time to perform the repair and multiplying it by the labor rate). It would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing such a way of determining the price in order to quickly determine a price of a number of jobs based on differing complexity and labor costs.

Claims 17, 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Slaight et al (2002/0077954).

As to claims 17, 31 and 32, Fields shows all elements except receiving repeated bids by a bidder, and providing bid information back to bidders so they can modify their bids. Slaight shows these steps. It would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing feedback and allowing repeated bids in order to assist the bidder in fixing problems in his bid.

As to claim 27-30, Fields shows all elements except generating a synthetic price from the ideal price calculated from the bid prices. Slaight shows this element (see e.g., Fig. 33). It would have been obvious to one of ordinary skill in the art to modify the

method of Fields by providing a synthetic price as claimed in order to assist in evaluating bids.

As to claim 28, Fields in view of Slaight show making the price available to bidders.

Claims , 22-25, 37, 49-56, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Vashistha et al (2001/0051913).

As to claim 37 and 49, Fields shows archiving a plurality of performances, each including a performance description and price; generating a list of desired performances; distributing the list to bidders; receiving a bid from at least one bidder including a price assigned to at least one performance; evaluating the received bids and selecting a bid; updating the archived descriptions with prices from the selected bid. Fields does not show that the selected bid is selected automatically. Vashistha show this. It would have been obvious to one of ordinary skill in the art to modify the method of Fields by automatically selecting a bid in order to reduce the amount of manual labor required in selecting the bid.

As to claim 52, Fields shows all elements except adding a performance. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method Fields by modifying or adding performance descriptions in order to allow for bidding on performances not contemplated by the existing database.

Regarding claims, 54 and 55, all elements are shown (e.g., Figs. 5, 7, 8 of Vashishta).

As to claim 56, Fields in view of Vashishta show comparing price among bidders, and versus the estimate; and determining negative performance via "virtual reputation" (e.g., Fig. 8 of Vashishta). It does not explicitly show selecting based on these elements. However, selecting a bid based on bid price, estimated price and historical information is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to choose the best blend of low price and high quality.

As to claims 22 and 23, Fields in view of Vashishta show evaluating the bids based on ideal price (comprising lowest price), estimated price, deviation from the lowest price and past performance.

As to claim 24, Fields in view of Vashishta show all elements except automatically determining a deviation from the ideal price. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of Fields by providing a deviation in order to assist in determining the best bid.

Response to Arguments

Applicant's arguments filed 11/14/2005 have been fully considered but they are not persuasive.

Regarding Applicant's arguments as to the "old and well known" rejection, the examiner respectfully disagrees. The examiner notes that an adequate traversal per MPEP 2144.03(c) requires the examiner to withdraw the rejection or provide evidence supporting it, no timely adequate traversal has been received. While the examiner notes that Applicant argued against the rejection in the previous rejection, the requirements of MPEP 2144.03(c) were not fulfilled because a statement of why the subject matter is not old and well known was not made. Applicant notes pages 17 and 18 of the response, but these pages deal with arguments as to why the rejection is not legally adequate and do not present any statement why the subject matter is not old and well known.

Regarding the 102 rejection over Fields, Applicant argues that the claimed "forwarding..." and "receiving a bid..." steps are not shown in Fields. The examiner respectfully disagrees. The examiner notes the Abstract, par. 0027, and the text of claims 1 and 2. This text explicitly recites receiving bids from the bidders.

Even if it were assumed *in arguendo* that the attorneys' actions in Fields are limited to the attorney accepting, rejecting, or deleting the RFP, the attorneys by deciding whether or not to accept the suggesting fee are determining a bid price.

As to applicant's argument regarding claim 10, the examiner first notes that he has made no admission regarding what is explicitly shown in the reference, but has merely made a statement that certain elements are inherently shown. Further arguments are moot in light of the new grounds of rejection of the claim.

Regarding dependent claims 2, 7-9,13-15, 18, 19, 26, 33 and 38-41, it is noted that all elements of the claims are disclosed by Fields and withdrawing the rejection would be improper.

Regarding the arguments directed to the "obvious matter of design choice" rejection, it is noted that a statement of motivation is not required in such a rejection because the theory of the rejection is that either option is equally desirable and essentially interchangeable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

Steven B. McAllister
Primary Examiner
Art Unit 3627

STEVE B. MCALLISTER
PRIMARY EXAMINER